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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,351	10/21/2003	Seth A. Foerster	A-1704con	4188

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EXAMINER

NGUYEN, VI X

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,351

Applicant(s)

FOERSTER ET AL.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2-5,9,11 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3-6,9,11 and 15-16 of **U.S. Patent No. 6,660,008**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same subject matters as following: a body includes a plurality of spaced slits, where each slits have a distance x between two adjacent slits at a first location along the length of each of the slits that is smaller than a distance y between the two adjacent slits at a second location along the length of each of the slits, where the plurality of spaced slits comprise at least six slits. Furthermore, Claims 1,3,7-9,11 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,4-6,8,11-15,17,22-23 and 25-26 of **U.S. Patent No. 6,582,453**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same subject matters as following: a body includes a plurality of spaced slits, where each slits have a distance x between two adjacent slits at a first location along the

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length of each of the slits that is smaller than a distance y between the two adjacent slits at a second location along the length of each of the slits, where the plurality of spaced slits comprise at least six slits, and where the plurality of spaced slits lie at an acute angle relative to the longitudinal axis, where the acute angle is between 0 and 45 degrees.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 is rejected as being incomplete because it depends from a cancelled claim.

Therefore, it has not been further analyzed on the merit.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 and 24 are rejected under 35 U.S.C. 102 (b) as being anticipated by Du Toit (U.S. 5,470,335).

Figures 2 and 11 of Du Toit shows a set of surgical instruments having all the limitation as recited in the above listed claims, including: a body (12) has a longitudinal axis, a proximal end and a distal end, where the body (12) has an outer peripheral wall which extends

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substantially completely about the longitudinal axis (see labeled in fig. 11), where the body includes a plurality of slits (18, fig. 2); and where the slits have a distance x between two adjacent slits which is smaller than a distance y between the two adjacent slits (see fig. 2).

As to claims 2-6, Du Toit discloses the slits (18) has an angled surface (fig. 2) at an end; where the body (12) has a cylindrical body (col. 5, lines 52-57); and where the slits (18) are generally parallel to the longitudinal axis (figs. 2 and 3).

As to claims 7-9 and 24, Du Toit discloses the slits (18) lie at an acute angle relative to the longitudinal axis, where the acute angle is between 0 and 45 degrees (col. 5, lines 65-67 and col. 6, lines 10-17); and where a plurality of spaced slits (18) has at-least six slits (col. 2, lines 40-47 and figs 2-3), and where the body can be placed in compression, and where the regions of the outer wall between the spaced slits can expand radially to extend into adjacent bone.

Claims 11-12 and 21-23 are rejected under 35 U.S.C. 102 (b) as being anticipated by Anspach, Jr. et al. (U.S. 5,501,695).

Figures 8 and 9 of Anspach, Jr. et al disclose an apparatus for attaching connective tissue to bone having all the limitation as recited in the above listed claims, including: a body (12) has a longitudinal axis, a proximal end and a distal end, where the body (12) has an outer peripheral wall which extends substantially completely about the longitudinal axis, wherein the body includes a plurality of slits (51) and each of the slits have a length and an angled surface (fig. 9) which extends into the body.

As to claims 21-23, Anspach et al disclose a method of making a pattern of a bone anchor (3,4) using a bio-compatible material (col. 3, lines 35-41), wherein forming a plurality of spaced

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slits (51) which is across a width of the pattern; wherein an angled surface is formed at each end of spaced slits (51, fig. 9).

Conclusion

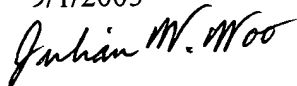
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn VJ
9/1/2005



JULIAN W. WOO
PRIMARY EXAMINER